

Amendment Under 37 C.F.R. §1.116
U.S. Patent Appln. No. 09/399,873

Docket No. 6169-95
IBM Docket No. BOC9-1998-0094

REMARKS:

These remarks are set forth in response to the final Office Action mailed November 6, 2002 (Office Action). As this amendment is timely filed within the three-month statutory period, neither an extension of time nor a fee is required. The Office Action indicated that the Terminal Disclaimer filed on August 12, 2002, was reviewed and accepted and that the claim amendments accompanying the Response filed on the same date were effective in overcoming the 35 U.S.C. § 112 rejection of claims 1 and 2. The Office Action further indicated, however, that the submission under 37 C.F.R. § 1.131 on August 12, 2002 was ineffective in overcoming U.S. Patent No. 6,324,499 to Lewis *et al.* (Lewis). In consequence, claims 1-12 stand rejected under 35 U.S.C. § 103(a) as being obvious over Lewis in view of Japanese Patent No. JP410091184A to Kawada *et al.* (Kawada).

The Applicants acknowledge with appreciation the helpful telephonic interviews with the Examiner which were conducted on December 18, 2002, and January 15, 2003. During both interviews, the sufficiency of the Applicants' submission under 37 C.F.R. § 1.131, and particularly the Applicants' disclosure (Disclosure) which accompanied each Declaration in the submission, was discussed in relation to the pending claims. The Applicants firmly assert that the Disclosure and Declarations submitted on August 12, 2002, were completely sufficient to overcome the Lewis reference. Accordingly, the Applicants take this opportunity to again address the issues raised by the Examiner during the telephonic interview of January 15, 2003.

Prior to discussing the substance of the Disclosure and Declarations, the Applicants note that paragraph 1 of the Office Action states that "Applicant has submitted a copy of a disclosure summarizing the concept of the invention, but the submission does not provide facts of reduction of practice." The Applicants respectfully note, however, that this is but one way of showing prior invention. Under 37 C.F.R. § 1.131(b) and MPEP §715.07, the Applicants' submission may show conception of the invention prior to the effective date of the reference coupled with due diligence from prior to said date to the filing of the application (constructive reduction to practice). Accordingly, it is this standard, conception prior to the effective date of the reference

Amendment Under 37 C.F.R. §1.116
U.S. Patent Appln. No. 09/399,873

Docket No. 6169-95
IBM Docket No. BOC9-1998-0094

coupled with due diligence from prior to said date to the filing of the application – not an actual reduction to practice – which must be applied in evaluating the Disclosure and the Declarations.

During the telephonic interview of January 16, 2003, the Examiner indicated that two issues remained outstanding with regard to the sufficiency of the Disclosure. The first issue related to whether the Disclosure supported the feature of "recording an isolated noise sample while operating a computer system component in isolation from other computer system components" as recited in claims 1 and 7. The second issue related to whether the Disclosure supported the feature of "suggesting a remedy for said excess noise" as recited in claims 2 and 8.

Regarding the first issue, support for recording an isolated noise sample while operating a computer system component in isolation from other computer system components can be found at multiple locations within the Disclosure, which has been submitted herewith for convenience. The Applicants note that the Figure 1 on page 3 of the Disclosure is a flow chart which includes the step of "record component under test (CUT) sample". The language is singular indicating that a single component can be exercised for testing purposes. The flow chart also includes a step for determining whether "additional components [are to be] test[ed]?" as well as a conclusion path labeled "switch to next component" indicating that a subsequent single component can be tested. Accordingly, Figure 1 illustrates a recursive process for testing components individually until no components remain to be tested.

Additionally, the Applicants note Figure 2 on page 4 of the Disclosure which illustrates a sample graphical user interface. The sample graphical user interface includes "check box" style selectors which enable a user to select a single test to be performed. The sample graphical user interface illustrates that one or more tests can be enabled either singly (in isolation) or in various combinations.

Finally, on page 4 of the Disclosure, point number 3 asks the question "[I]f the same advantage or problem has been identified by others (inside/outside of IBM), how have those others solved it and does your solution differ and why is it better?" In response, the Applicants discuss the shortcomings of conventional noise detection

Amendment Under 37 C.F.R. §1.116
U.S. Patent Appln. No. 09/399,873

Docket No. 6169-95
IBM Docket No. BOC9-1998-0094

instruments which sense only gross signal to noise ratios. These conventional noise detection instruments do not discern which particular sub-system is the source of noise. Thus, it is this deficiency, at least in part, which the Applicants' invention is intended to overcome.

In consequence, the Disclosure clearly indicates conception of the notion of "recording an isolated noise sample while operating a computer system component in isolation from other computer system components" which predates the Lewis reference.

Regarding the second issue, the Disclosure also provides support for suggesting a remedy for identified excess noise. In support, the Applicants note page 2 of the Disclosure which states in relevant part that "[t]his information can then be presented to the user, with possible solutions, in a readable format (see Figure 2)." Figure 1 on page 3 of the Disclosure further depicts a step of "display/log information" and the sample graphical user interface of Figure 2, which is shown on page 4 of the Disclosure, includes a "Test Information" window for presenting such information. Thus, the Applicants' disclosure clearly indicates conception of the notion of suggesting a remedy for identified excess noise which predates the Lewis reference.

Summarizing, the Applicants' disclosure clearly indicates conception of both "recording an isolated noise sample while operating a computer system component in isolation from other computer system components" and "suggesting a remedy for said identified excess noise." Moreover, the Applicants exercised due diligence from prior to the effective date of the Lewis reference up to the filing of the instant patent application as evidenced by the recitations in each Declaration stating in relevant part that (1) International Business Machines Corporation (IBM) invests substantial time and effort into the research, development, and marketing of their products, as well as the protection of its rights in all new inventions, and that (2) IBM requires all employees to prepare and submit IBM Confidential Invention Disclosure Forms upon conception by each inventor.

In consequence, the Affidavits filed on August 7, 2002, are fully sufficient to overcome the Lewis reference. As the 35 U.S.C. § 103(a) rejection of claims 1-12

Amendment Under 37 C.F.R. §1.116
U.S. Patent Appln. No. 09/399,873

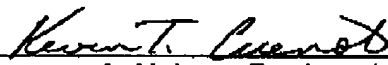
Docket No. 6169-95
IBM Docket No. BOC9-1998-0094

cannot stand without the primary reference (Lewis), withdrawal of the 35 U.S.C. § 103(a) rejection with respect to claims 1-12 is respectfully requested.

In view of the foregoing, claims 1-12 are believed to be allowable. This entire application is now believed to be in condition for allowance. Accordingly, such action is respectfully requested. The Applicants request that the Examiner call the undersigned if clarification is needed on any matter within this Response, or if the Examiner believes a telephone interview would expedite the prosecution of the subject application to completion.

Respectfully submitted,

Date: 2/6/03


Gregory A. Nelson, Registration No. 30,577
Kevin T. Cuenot, Registration No. 46,283
AKERMAN SENTERFITT
222 Lakeview Avenue, Suite 400
Post Office Box 3188
West Palm Beach, FL 33402-3188
Telephone: (561) 653-5000

Amendment Under 37 C.F.R. §1.116
U.S. Patent Appln. No. 09/399,873

Docket No. 6169-95
IBM Docket No. BOC9-1998-0094

PENDING CLAIMS

1. (Previously Amended) A method for identifying excess noise in a computer system comprising the steps of: *4: 65-67*
recording a silence sample;
second recording an isolated noise sample while operating a computer system component in isolation from other computer system components;
comparing signal characteristics of said silence sample with signal characteristics of said isolated noise sample; and,
attributing said isolated noise sample to said isolated computer component when said signal characteristics of said silence sample differ by a preset threshold from said signal characteristics of said isolated noise sample.
2. (Previously Amended) A method according to claim 1, further comprising the steps of:
logging said signal characteristics of said silence sample and said isolated noise sample;
reporting excess noise identified in said attributing step; and,
suggesting a remedy for said identified excess noise.
3. (Original) A method according to claim 1, further comprising the steps of:
creating a list of computer system components to be tested for excess noise;
and,
associating with each component in said list a corresponding method for testing said component for excess noise.
4. (Original) A method according to claim 2, further comprising the steps of:
creating a list of computer system components to be tested for excess noise;
first associating with each component in said list a corresponding method for testing said component for excess noise; and,

Amendment Under 37 C.F.R. §1.116
U.S. Patent Appln. No. 09/399,873

Docket No. 6169-95
IBM Docket No. BOC9-1998-0094

second associating with each component in said list a corresponding remedy for excess noise identified in said corresponding component.

5. (Original) A method according to claim 3, wherein said second recording step comprises for each computer system component in said created list of computer system components to be tested for excess noise, second recording an isolated noise sample while operating each said computer system component in said created list according to said corresponding method.

6. (Original) A method according to claim 4, wherein said second recording step comprises for each computer system component in said created list of computer system components to be tested for excess noise, second recording an isolated noise sample while operating each said computer system component in said created list according to said corresponding method, and said suggesting step comprises suggesting said corresponding remedy for said identified excess noise in each said computer system component in said created list.

7. (Original) A computer apparatus programmed with a routine set of instructions stored in a fixed medium, said computer apparatus comprising:

first means for recording a silence sample;

second means for recording an isolated noise sample while operating a computer system component in isolation from other computer system components;

means for comparing signal characteristics of said silence sample with signal characteristics of said isolated noise sample; and,

means for identifying excess noise stemming from said isolated computer system component where said signal characteristics of said silence sample differ by a preset threshold from said signal characteristics of said isolated noise sample.

Amendment Under 37 C.F.R. §1.116
U.S. Patent Appln. No. 09/399,873

Docket No. 6169-95
IBM Docket No. BOC9-1998-0094

-
8. (Original) A computer apparatus according to claim 7, further comprising:
means for logging said signal characteristics of said silence sample and said isolated noise sample;
means for reporting excess noise identified by said identifying means; and,
means for suggesting a remedy for said identified excess noise.
9. (Original) A computer apparatus according to claim 7, further comprising:
a list of computer system components to be tested for excess noise; and,
test instructions corresponding to each said computer system component in said list.
10. (Original) A computer apparatus according to claim 8, further comprising:
a list of computer system components to be tested for excess noise;
test instructions corresponding to each said computer system component in said list; and,
a plurality of suggested remedies for identified excess noise, each said suggested remedy corresponding to at least one of said computer system components in said list.
11. (Original) A computer apparatus according to claim 9, wherein said second recording means comprises for each computer system component in said list of computer system components to be tested for excess noise, means for second recording an isolated noise sample while operating each said computer system component in said list according to said corresponding test instructions.
12. (Original) A computer apparatus according to claim 10, wherein said second recording means comprises for each computer system component in said list of computer system components to be tested for excess noise, means for second recording an isolated noise sample while operating each said computer system component in said list according to said corresponding test instructions, and said

Amendment Under 37 C.F.R. §1.116
U.S. Patent Appln. No. 09/399,873

Docket No. 6169-95
IBM Docket No. BOC9-1998-0094

suggesting means comprises means for suggesting said corresponding suggested remedy for said identified excess noise in each said computer system component in said list.